

Application No.: 10/743,667
Amendment Dated: November 17, 2008
Reply to Office Action Mailed: August 4, 2008

REMARKS/ARGUMENTS

Claims 1, 3, 4 and 7 through 26 are pending in the instant application. The applicants have amended claims 1, 15 and 22, support for which may be found in Figs. 1 and 2, as originally filed, and elsewhere throughout applicants' specification. No new matter is added.

The Examiner has rejected claims 1, 4, 7 and 11 through 13 under 35 U.S.C. 102(b) as being anticipated by Fuchs et al., U.S. Patent No. 4,291,698. The Examiner has rejected claims 8, 9 and 15 through 26 under 35 U.S.C. 103(a) as being unpatentable over Fuchs et al., U.S. Patent No. 4,291,698, in view of Kammerer et al., U.S. Patent No. 6,152,935. The rejection of applicants' claims, as amended, is respectfully traversed. Reconsideration and favorable action is respectfully solicited in view of the following comments.

The Examiner has rejected claims 1, 4, 7 and 11 through 13 under 35 U.S.C. 102(b) as being anticipated by Fuchs et al., U.S. Patent No. 4,291,698. Fuchs et al., U.S. Patent No. 4,291,698, proposes a button for surgical applications comprising a disk having a slot which extends to a passage for guiding a thread therethrough within the circumference of the disk, said passage being sealed by a clamping device for clamping the thread firmly in the passage. The clamping device includes a disk segment movable parallel with the disk over the slot and passage to a latched position where its inner marginal part is past the passage thereby bending the thread and holding it by friction and compression. The Examiner remains of the view that:

Regarding Claim 1, Fuchs teaches a suture anchoring device comprising: a first retaining member (21) having a first surface, a second surface and a first outer edge; where the second surface lies in a first plane; the first

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retaining member having an opening that extends from the first outer edge to an inner point of the first retaining member; a second retaining member having a third surface, a fourth surface, a fifth surface, a sixth surface and a second outer edge; where the third surface lies in a second plane, and the fifth surface and the sixth surface lie nominally perpendicular to the second outer edge at their lines of intersection therewith; a holding means positioned within the second retaining member, the holding means comprised of an opening extending from the fifth or the sixth surface to within the second retaining member; and a coupler having a third outer edge and a cross-sectional area taken in a plane parallel to the first plane that is smaller than the cross-sectional area of the first retaining member taken in a plane parallel to the first plane; where the coupler is positioned axially (the coupler is on an axis, the claim does not state the location of the axis or state the coupler is positioned on a central longitudinal axis of the first and second retaining members) between and joins the first retaining member to the second retaining member at the second surface and the third surface; wherein the second and third surfaces are parallel to each other and non-coterminous ...

A careful review of Fuchs et al. reveals that Fuchs et al. fail to disclose suture anchoring device comprising: a first retaining member having a central longitudinal axis, a first surface, a second surface and a first outer edge; where the second surface lies in a first plane; the first retaining member having an opening that extends from the first outer edge to an inner point of the first retaining member; a second retaining member having a central longitudinal axis, a third surface, a fourth surface, a fifth surface, a sixth surface and a second outer edge; where the third surface lies in a second plane and the fifth surface and the sixth surface lie nominally perpendicular to the second outer edge at their lines of intersection therewith; a holding means positioned within the second retaining member, the holding means comprised of an opening extending from the fifth or the sixth surface to within the second retaining member; and a coupler having a third outer edge and a cross-sectional area taken in a plane parallel to the first plane that is smaller than the cross-sectional area of the first retaining member taken in a plane parallel to the first plane; where the coupler is positioned along said central longitudinal axis of said first retaining member and said second retaining member and joins the first retaining member to the second

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retaining member at the second surface and the third surface; wherein the second and third surfaces are parallel to each other and non-coterminous and the opening on the first retaining member extends from the first outer edge to the third outer edge of the coupler. [Emphasis added].

As stated in MPEP § 2131, in order to constitute anticipation under the law, a patent or publication must contain within its four corners a sufficient description to enable the person of ordinary skill to make the invention without undue experimentation. All material elements of a claim must be found in one prior art source, a mere suggestion is not enough and essential elements are not to be read into a reference. If a reference does not expressly recite or disclose applicants' claimed invention, as is the case here, then, it is required under principles of inherency that the claimed subject matter be inevitably produced when the teachings of the relied upon reference are followed, in order for a proper case of anticipation to be found.

It is respectfully submitted that applicants' claimed invention is not fairly taught, and that following the teachings of Fuchs et al. would not inevitably produce the invention, as claimed. In view thereof, it is respectfully requested that the grounds for rejection of claims 1, 4, 7 and 11 through 13 under 35 U.S.C. 102(b) as being anticipated by Fuchs et al., U.S. Patent No. 4,291,698, be withdrawn.

The Examiner has rejected claims 8, 9 and 15 through 26 under 35 U.S.C. 103(a) as being unpatentable over Fuchs et al., U.S. Patent No. 4,291,698, in view of Kammerer et al., U.S. Patent No. 6,152,935. The Examiner remains of the view that:

Regarding Claims 15 and 22, Fuchs teaches a suture anchoring device comprising: a first retaining member (21) having a first surface, a second surface and a first outer edge; where the second surface lies in a first plane;

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the first retaining member having an opening that extends from the first outer edge to an inner point of the first retaining member; a second retaining member having a third surface, a fourth surface, a fifth surface, a sixth surface and a second outer edge; where the third surface lies in a second plane, and the fifth surface and the sixth surface lie nominally perpendicular to the second outer edge at their lines of intersection therewith; a holding means positioned within the second retaining member, the holding means comprised of an opening extending from the fifth or the sixth surface to within the second retaining member; and a coupler having a third outer edge and a cross-sectional area taken in a plane parallel to the first plane that is smaller than the cross-sectional area of the first retaining member taken in a plane parallel to the first plane; where the coupler is positioned axially (the coupler is on an axis, the claim does not state the location of the axis or state the coupler is positioned on a central longitudinal axis of the first and second retaining members) between joins the first retaining member to the second retaining member at the second surface and the third surface; wherein the second and third surfaces are parallel to each other and non-coterminous ...

The deficiencies of Fuchs et al. are discussed above and reiterated here. Kammerer et al. disclose an H-type fastener for tissue having a central spring member (Abstract). It must initially be noted that Kammerer et al. fails to remedy the deficiencies of Fuchs et al., noted above.

The Examiner suggests that "Kammerer teaches a tension spring, [and] this device would be biased against closing" (Office Action, page 10).

Since the "helical member" of Kammerer et al. is a tension spring, if placed into the position of the Fuchs et al. flexible hinge 3 (Fuchs et al., col. 4, line 50), as proposed by the Examiner, the Fuchs et al. device would be biased against closing, thus destroying its function.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).
MPEP 2143.01

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In view thereof, it is respectfully requested that the grounds for rejection of claims 8, 9 and 15 through 26 under 35 U.S.C. 103(a) as being unpatentable over Fuchs et al., U.S. Patent No. 4,291,698, in view of Kammerer et al., U.S. Patent No. 6,152,935, be withdrawn.

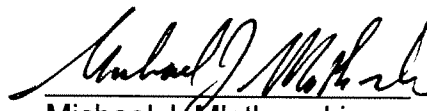
The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 50-2478(13792).

In view of the foregoing, it is respectfully submitted that the present claims be in condition for allowance. Prompt notification of allowance is respectfully solicited.

If the Examiner has any questions or wishes to discuss this application, the Examiner is invited to contact the undersigned representative at the number set forth below.

Respectfully submitted,

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